UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/750,322	01/02/2004	Timothy Joseph Johnson	CRNI.110509	4676

46169 7590 06/09/2009

SHOOK, HARDY & BACON L.L.P.
Intellectual Property Department
2555 GRAND BOULEVARD
KANSAS CITY, MO 64108-2613

EXAMINER	
NGUYEN, TRAN N	

ART UNIT	PAPER NUMBER
3626	

MAIL DATE	DELIVERY MODE
06/09/2009	PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No.	Applicant(s)	
	10/750,322	JOHNSON, TIMOTHY JOSEPH	
	Examiner	Art Unit	
	Tran Nguyen	3626	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *3* MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *25 March 2009*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1,4,6,7,9-12,15-23 and 26-38* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1,4,6,7,9-12,15-23 and 26-38* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____ .
5) ☐ Notice of Informal Patent Application
6) ☐ Other: _____.

DETAILED ACTION

Notice to Applicant

This communication is in response to the communication filed 03/27/2009. Pending claim(s): 1, 4, 6-7, 9-12, 15-23, 26-38. Cancelled claim(s): 2-3, 5, 8, 13-14, 24-25. Amended claim(s): 1, 4, 6-7, 9, 12, 15, 17-21, 23, 26, 28-31, 34-38.

Continued Examination Under 37 CFR 1.114

A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 03/27/2009 has been entered.

Response to Amendment

On 08/13/2008, Applicant filed the following amendment:

Please replace paragraph [0012] of the published application (ptpub.) with the following amended paragraph:

[0012] Fig. 1 illustrates an architecture in which a system and method for automatic conditioning of clinically related billing may operate, according to an embodiment of the invention. A "system," or computer system, as utilized herein, refers to a configuration that includes all functional components of a computer and its associated hardware. A basic microcomputer system includes a console, or a system unit, within one or more disk drives, a monitor, and a keyboard. Additional hardware, called peripherals, can include such devices as a printer, a modem, and a mouse. As illustrated in that figure, in embodiments a clinical event 102

It appears that Applicant is requesting that the Pre-Grant Publication be amended.

Because the PGPub is not part of the Official file, this amendment does not materially affect the specification in the Official file, and is immaterial to the merits of the instant pending application.

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

> The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 4, 7, 9, 12, 15-22, 27, 30, 34-35 are rejected under 35 U.S.C. 112, first paragraph.

As per claim 4, this claim recites:

automatically scanning ancillary clinical data stores for the supporting documentation;

The specification discloses (page 7 paragraph 0028):

As used herein, "documentation" may refer broadly to any hard copy, electronic, optical or other report, data, file or other media or content, in textual, numeric or other format, which temporarily or permanently reflects or records information related to the delivery of clinical care.

As provided for by the specification, Examiner interprets "documentation" to recite any data, including hard copy data.

As recited in claim 4, the claim requires automatically searching for "documentation", including automatically searching for hard copy data.

Accordingly, the specification, while being enabling for automatically searching computerized data, does not reasonably provide enablement for automatically searching hard copy data. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims.

Specifically, one of ordinary skill in the art would not know how to make and use the feature of automatically searching hardcopy data.

As per claims 7, 9, 12, 15-22, 27, 30, 34-35, these claims are rejected for substantially the same rationale as applied to claim 4 above, and incorporated herein.

The following is a quotation of the second paragraph of 35 U.S.C. 112:

> The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claim(s) 4, 34, 38 is/are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

As per claim 34, this claim recites “wherein the computer software components further comprise”.

Parent claim 1 previously recited “a computer system… having a plurality of computer software components”; however, this recitation appears in the preamble.

The recitation “a plurality of computer software components” has not been given patentable weight because the recitation occurs in the preamble. A preamble is generally not accorded any patentable weight where it merely recites the purpose of a process or the intended use of a structure, and where the body of the claim does not depend on the preamble for completeness but, instead, the process steps or structural limitations are able to stand alone. See *In re Hirao*, 535 F.2d 67, 190 USPQ 15 (CCPA 1976) and *Kropa v. Robie*, 187 F.2d 150, 152, 88 USPQ 478, 481 (CCPA 1951).

The limitation in claim 34 renders claim 34 indefinite because Examiner cannot determine if the preamble of claim 1, namely the "plurality of computer software components", limit the scope of claim 1 because claim 34 further limits this feature.

For purposes of applying prior art, Examiner interprets the "plurality of computer software components" to be a structural limitation of the claimed system.

All claims dependent thereon, namely claim 4, fail to remedy these deficiencies, and are rejected for at least the same rationale above, and incorporated herein.

Claim 38 recites:

> wherein the compliance template comprising necessary comprises the criteria necessary for qualifying the preliminary billing item under the at least one regulatory guideline.

Examiner cannot ascertain the scope of the limitation "the compliance template comprising necessary comprises the criteria necessary for qualifying".

For purposes of applying prior art, Examiner interprets this limitation to recite "the compliance template comprising criteria necessary for qualifying".

Additional clarification is requested.

Claim Rejections - 35 USC § 101

35 U.S.C. 101 reads as follows:

> Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claim(s) 1, 4, 6-7, 9-12, 15-23, 26-38 is/are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

As per claim 1, this claim recites a “system” comprising a “conditioning engine".

The claim recites no further structural limitation of the claimed system.

Applicant provides no definition for “engine”.

Merriam-Webster Online Dictionary defines “engine” as “computer software that performs a fundamental function especially of a larger program”.

When read in light of the specification and the level of ordinary skill in the art, Examiner interprets the claimed system of claim 1 to recite software *per se*.

As such, claim 1 is found to be directed towards nonstatutory subject matter.

All claims dependent thereon, namely claims 1, 4, 6-7, 9-11, 34, 37-38, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

As per claim 12, based on Supreme Court precedent and recent Federal Circuit decisions, the Office's guidance to examiners is that a § 101 process must (1) be tied to a machine or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. *In re Bilski* et al, 88 USPQ 2d 1385 CAFC (2008); *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780,787-88 (1876).

An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps. Thus, to qualify as a statutory process, the claim should positively recite the particular machine to which it is tied, for example by identifying the apparatus that accomplishes the method steps, or positively recite the subject matter that is being transformed, for example by identifying the material that is being changed to a different state.

Claim 12 recites a "method" comprising a plurality of method steps; however, none of the recited steps requires the particular of a statutory machine. As such, the claim fails the “machine” prong of the test.

Additionally, the processing recited in claim 12, including generating a compliant bill and forwarding the bill to a third party, does not amount to a physical transformation because the claimed method steps amount to mere data transformation at best. As such, the claim fails the “transformation” prong of the test.

Because the claim fails both prongs of the “machine or transformation” test, the claim is found to be directed towards nonstatutory subject matter.

All claims dependent thereon, namely claims 15-22, 35, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

As per claim 23, this claim recites ”computer-readable storage media”.

The specification discloses (page 7 paragraph 0028):

> As used herein, "documentation" may refer broadly to any hard copy, electronic, optical or other report, data, file or other media or content, in textual, numeric or other format, which temporarily or permanently reflects or records information related to the delivery of clinical care.

Accordingly, the specification provides any hard copy, electronic, optical or other report, data, and file as exemplary embodiments of "media".

When read in light of the specification and the level of ordinary skill in the art, Examiner interprets "computer-readable storage media" to encompass nonstatutory embodiments as provided by the specification.

Therefore, claim 23 encompasses nonstatutory embodiments, including software *per se* and other forms of media that are not considered to be a physical article of manufacture.

All claims dependent thereon, namely claims 126-33, 36, fail to remedy these deficiencies, and are therefore rejected for at least the same rationale above, and incorporated herein.

Additional clarification is requested.

Claim Rejections - 35 USC § 102

The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

Claim(s) 1, 6, 10-11, 23, 26-29, 32-33, 36-38 is/are rejected under 35 U.S.C. 102(e) as being anticipated by Fitzgerald (20030191667).

As per claim 1, Fitzgerald teaches a computer system (page 3 paragraph 0023) capable of processing (reads on “conditioning”) patient claim data (reads on “clinically related billing items”) (Abstract), wherein the computer contains thereon a plurality of software applications (reads on “computer software components”) (page 3 paragraph 0023), comprising:

(a) software (reads on “a conditioning engine”) (Figure 1-2) capable of:

(i) retrieving (reads on “receiving”) a patient claim billing record capable of being submitted for pre-processing by trial adjudicator software (reads on "preliminary billing item") (page 3 paragraph 0025) for a patient encounter with a healthcare provider concerning treatment of an injury (reads on “associated with a clinical event") (Figure 4);

(ii) verifying the claim for accuracy (reads on “analyzing”) before (reads on “a condition precedent to") the claim is submitted for payment (reads on “transmitting the billing item to a paying party”) (page 2 paragraph 0021) by comparing the claim against a plurality of rules (reads on “comparison against a compliance template to

determine compliance therewith", wherein the rule is considered to be a "compliance template") (page 2 paragraph 0021).

Claim 1 further recites:

> the preliminary billing item generated from billable items extracted from the clinical event, wherein the billable items comprise insurance coverage data and information supporting the billing of services or materials;

As currently recited, the "preliminary billing item" has not been positively recited as a structural limitation of the claimed "system". Insofar as this limitation above is concerned, Examiner interprets this limitation to recite that the claimed "conditioning engine" is capable of receiving a preliminary item generated in any manner so long as the received preliminary billing item comprises "insurance coverage data and information support the billing of services or materials".

In effect, as long as the prior art teaches a computer system capable of receiving a "preliminary billing item" comprising "insurance coverage data and information support the billing of services or materials", this teaching would fully anticipate the claimed limitation.

In the interest of compact prosecution for Applicant, Examiner has applied art to features that are not actually part of the claimed system should Applicant properly amend the claimed system to encompass these features.

Fitzgerald further teaches:

(b) the computer system is capable of receiving a claim comprising insurance data and billed medical services (reads on "information supporting the billing of services or materials") (Figure 4).

Claim 1 further recites:

> the compliance template ~~is~~ that includes criteria configured ~~in accordance with~~ based on the preliminary billing item and at least one regulatory guideline and comprises data fields, which correspond to each of the criteria, respectively, that record information that satisfies the criteria, wherein the criteria ~~that~~, when satisfied, qualify the preliminary billing item under the at least one regulatory guideline,

The "compliance template" has not been positively recited as a structural limitation of the claimed system.

Insofar as the "compliance template" is concerned, Examiner interprets this limitation as a data structure capable of being used by the claimed "conditioning engine"; however, the "compliance template" itself is not considered to be part of the claimed system.

Additionally, none of the features recited above actually require the use of the claimed "conditioning engine". Therefore, these limitations do not limit the scope of the claim.

Insofar as the features of the "compliance template" is concerned, as long as the prior art teaches a data structure capable of being used by a computer to compare

against claim data to determine compliance, this teaching would fully anticipate the claimed feature.

In the interest of compact prosecution for Applicant, Examiner has applied art to features that are not actually part of the claimed system should Applicant properly amend the claimed system to encompass these features.

Fitzgerald further teaches:

(c) the rules to be applied are selected based on:

(i) the claim, e.g. selecting the applicable rule based on the intended payor of the claim (page 3 paragraph 0026);

(ii) Medicare guidelines (reads on “at least one regulatory guideline”) (page 5 paragraph 0036);

(iii) wherein the rules comprise data represent payor requirements and Medicare guidelines (reads on "data fields, which correspond to each of the criteria") that must be satisfied according to Medicare guidelines (page 5 paragraph 0036-0037);

(d) wherein the computer system is capable of, after the claim is evaluated for accuracy (reads on “upon determining that the billing item complies”), clearing error codes (reads on “dismissing restrictions from elements in the system that prevent the system from configuring the conditioning engine to transmit the preliminary billing item to the paying party”) (page 6 paragraph 0039) and submitting the claim for payment (page 2 paragraph 0021).

As per claim 6, Fitzgerald teaches holding a claim (reads on "holds queue") if the claim data is not in compliance with the rules (reads on "an exception") (page 5 paragraph 0037, Figure 5) if the claim is missing the insured's last name (Figure 10 label 609).

As per claim 10, Fitzgerald teaches storing the rules in a rules warehouse (reads on a "compliance database") (Figure 2 label 78).

As per claim 11, Fitzgerald teaches that the rules database is capable of being continuously updated (page 2 paragraph 0019).

As per the set of claim(s): 23, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, respectively, and incorporated herein.

As per claim 26, Fitzgerald teaches using the rules to check for missing claim data (Figure 10).

As per claim 27, Fitzgerald teaches using patient data (reads on "a patient chart") (Figure 10).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per the set of claim(s): 28, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 6, respectively, and incorporated herein.

As per claim 29, Fitzgerald teaches correcting the claim and resubmitting the claim (reads on “while the exception remains in the holds queue”) (page 7 paragraph 0047 and throughout).

As per the set of claim(s): 32, 33, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 10, 11, respectively, and incorporated herein.

As per claim 36, Fitzgerald teaches healthcare compliance rules mandated by regulators comprising diagnosis codes, CCI requirements, APGs, DRGs (reads on “affirming data elements”) (page 3 paragraph 0026).

As per claim 37, Fitzgerald teaches associating a rule with an event, wherein the event specifies that new claim data is available for processing (reads on "extracting the billable items from a clinical data store") (page 5 paragraph 0033).

As per the set of claim(s): 38, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 1, respectively, and incorporated herein.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

The factual inquiries set forth in *Graham* **v.** *John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claim(s) 4, 7, 9, 12, 15-22, 30-31, 34-35 is/are rejected under 35 U.S.C. 103(a) as being unpatentable over Fitzgerald in view of Barber (4858121).

As per claim 34, Fitzgerald teaches that a claim is missing the insured's last name (Figure 10 label 609). Fitzgerald further teaches returning the claim to the submitter for correction (page 6 paragraph 0039-0040).

Fitzgerald does not teach "affirming data elements that provide a record of services delivered with respect to the clinical event in the form of supporting documentation, which is absent from the preliminary billing item".

According to Fitzgerald, the insured's identification data, e.g. last name, is missing from the claim.

Barber teaches using stored patient identification data to complete claims (column 5 line 50-55).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Barber within the embodiment of Fitzgerald with the motivation of eliminating entry of patient identification data each time the data is needed (Barber; column 5 line 54-55).

As per the set of claim(s): 4, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 34, respectively, and incorporated herein.

In particular, Fitzgerald teaches correcting errors in the claim, including updated the missing patient identification data, and resubmitting the claim for processing (page 6 paragraph 0039-0040).

As per the set of claim(s): 7, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 34, respectively, and incorporated herein.

Examiner interprets retrieving patient identification data from the system, as taught by Barber, to be “automatically retrieving” because the retrieval is computer-implemented.

As per claim 9, Fitzgerald teaches amending the claim if necessary (reads on “while in the holds queue”) before submitting the claim for payment (page 6 paragraph 0042). Fitzgerald further teaches that upon determination of an exception condition, the system is capable of scheduling manual intervention or providing an alert (page 4 paragraph 0029).

As per claim 12, Fitzgerald teaches a method (page 7 paragraph 0049) capable of processing (reads on “conditioning”) patient claim data (reads on “clinically related billing items”) (Abstract), comprising:

(a) retrieving (reads on “receiving”) a patient claim billing record capable of being submitted for pre-processing by trial adjudicator software (reads on "preliminary billing item") (page 3 paragraph 0025) for a patient encounter with a healthcare provider concerning treatment of an injury (reads on “associated with a clinical event") (Figure 4).

Claim 12 further recites:

> wherein the preliminary billing item is generated from billable items extracted from the clinical event;

The method claim previously recited “receiving a preliminary billing item”.

Examiner, relying on *Ex parte Pfeiffer* 135 USPQ 31 (BPAI 961), maintains that "to be entitled to weight in method claims, recited structural limitations must affect the method in a manipulative sense and not amount to mere claiming of a use of a particular structure."

Accordingly, the manner in which the "preliminary billing item" was generated does not materially affect the scope of the method claim provided the "preliminary billing item" as taught by the art is capable of: a) being received, and b) being associated with a clinical event.

Because the generating step has not been positively recited as part of the claimed method, and the effects of the generating step does not materially affect the scope of the claim, this limitation does not limit the scope of the claim.

In the interest of compact prosecution for Applicant, Examiner has applied art to features that are not actually part of the claimed system should Applicant properly amend the claimed system to encompass these features.

Fitzgerald teaches:

(b) receiving a claim comprising insurance data and billed medical services (reads on "generated from billable items extracted from the clinical event") (Figure 4);

(c) verifying the claim for accuracy (reads on "analyzing") before (reads on "a condition precedent to") the claim is submitted for payment (reads on "transmitting the billing item to a paying party") (page 2 paragraph 0021) by comparing the claim against a plurality of rules comprising a Medicare guideline (page 2 paragraph 0021, page 5 paragraph 0036);

(d) comparing the claim against a plurality of rules comprising a Medicare guideline (page 2 paragraph 0021, page 5 paragraph 0036), comprising:

(a) selecting the rules to be applied based on:

(i) the claim, e.g. selecting the applicable rule based on the intended payor of the claim (page 3 paragraph 0026);

(ii) Medicare guidelines (reads on "at least one regulatory guideline") (page 5 paragraph 0036);

(b) determining that the insured's last name is missing (Figure 10 label 609) (reads on "some of the criteria remains unsatisfied upon comparison").

Fitzgerald does not teach "automatically scanning ancillary clinical data stores for the supporting documentation".

Barber teaches using stored patient identification data to complete claims (column 5 line 50-55).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to include the teachings of Barber within the embodiment of Fitzgerald with the motivation of eliminating entry of patient identification data each time the data is needed (Barber; column 5 line 54-55).

Fitzgerald further teaches:

(c) after the claim is evaluated for accuracy and errors are corrected, clearing error codes (page 6 paragraph 0039) and submitting the claim for payment (page 2 paragraph 0021) (Examiner considers the corrected insured's last name to be "annotations" because the insured's last name was not part of the original claim).

As per claim 15, Fitzgerald teaches using the rules to check for missing claim data (Figure 10).

As per claim 16, Fitzgerald teaches using patient data (reads on “a patient chart”) (Figure 10).

Insofar as the remainder of the claim is concerned, the applied art need not teach these limitations in view of the optional limitations recited therein.

As per the set of claim(s): 17, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 6, respectively, and incorporated herein.

As per claim 18, Fitzgerald teaches that the rules are updated from external rule sources (page 4 paragraph 0028). Fitzgerald further teaches applying new rules to claims (page 4 paragraph 0028-0029).

At the time the invention was made, it would have been obvious to one of ordinary skill in the art to apply a new set of rules within the embodiment of Fitzgerald and Barber with the motivation of applying the most current version of the rules.

As per the set of claim(s): 19, 20, 21, 22, 30, 31, this set of claim is rejected for substantially the same rationale as applied to the rejection of the set of claim(s): 4, 4, 10, 11, 4, 4, respectively, and incorporated herein.

As per claim 35, Fitzgerald teaches healthcare compliance rules mandated by regulators comprising diagnosis codes, CCI requirements, APGs, DRGs (reads on "affirming data elements") (page 3 paragraph 0026).

Response to Arguments

Applicant's arguments filed 03/25/2009 have been fully considered but they are not persuasive.

As per claim 1, on page 14 Applicant asserts:

As recommended by the Examiner on page 4, lines 11 and 12, of the Office Action, the compliance template is positively recited as part of the claimed computer system. Pursuant to this recommendation, the amended claim 1 recites a computer system comprising "the compliance template that includes *criteria configured based on the preliminary billing item and at least one regulatory guideline and comprises data fields*, which correspond to each of the criteria, respectively, *that record information that satisfies the criteria*, wherein the criteria, when satisfied, qualify the preliminary billing item under the at least one regulatory guideline" (emphasis added). In this way, the compliance template is claimed as a structural element, where the compliance template is required to have criteria and corresponding data fields that are based on (a) the preliminary billing item, and (b) at least one regulatory guideline. Further, as claimed, the compliance template must include criteria (e.g., criteria of compliance template 122 of FIG. 2 that includes physician referral, physician orders, etc.) that is dynamically selected based on, in part, attributes of the preliminary billing item.

Applicant's amendment failed to positively recite the "compliance template" as part of the claimed "system'. See the section above for a discussion of this limitation.

On page 15 Applicant further argues:

> The Fitzgerald reference does not disclose a process for determining compliance of a preliminary billing item that includes comparing the preliminary billing item against a compliance template that has the features of (a) criteria configured based on the preliminary billing item and at least one regulatory guideline, and (b) data fields, which correspond to each of the criteria, respectively, that record information that satisfies the criteria. Instead, Fitzgerald evaluates claim data—related to provision of healthcare—for accuracy by using rules to validate the claim data for processing payment.[5] These rules are derived from a repository and may be continuously updated and maintained.[6] Further, these rules may contain one or more tests to identify a true condition and initiate a first set of actions or a false condition and initiate a second set of actions.[7] However, these rules are not comparable to the positively claimed structure of the compliance template. Moreover, the rules are not selected based on both (a) the preliminary billing item and (b) at least one regulatory guideline, but generally derived from a repository, as discussed above. As such, for at least this reason, the Fitzgerald reference does not teach each and every element of the independent claims 1, 12, and 23.

First, this argument is not applicable to claim 1 because claim 1 recites a "system".

Second, in response to applicant's argument that the references fail to show certain features of applicant's invention, it is noted that the features upon which applicant relies (i.e., a compliance template comprising criteria based on the billing item and a regulatory guideline, and data fields for each criteria) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

Thirds, assuming *arguendo* that limitation flows inherently therefrom, Fitzgerald teaches:

(c) the rules to be applied are selected based on:

(i) the claim, e.g. selecting the applicable rule based on the intended payor of the claim (page 3 paragraph 0026);

(ii) Medicare guidelines (reads on “at least one regulatory guideline”) (page 5 paragraph 0036);

(iii) wherein the rules comprise data represent payor requirements and Medicare guidelines (reads on "data fields, which correspond to each of the criteria") that must be satisfied according to Medicare guidelines (page 5 paragraph 0036-0037).

Therefore, the applied art fully anticipate the argued features.

As per Applicant’s arguments directed towards claim 23, similar rationale above applies.

Applicant's arguments with respect to claims 12, 34, 4 on page 16-18 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tran (Ken) N. Nguyen whose telephone number is 571-

270-1310. The examiner can normally be reached on Monday - Friday, 9:00 am - 5:00 pm Eastern.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, C. Luke Gilligan can be reached on 571-272-6770. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/T. N./
Examiner, Art Unit 3626
06/05/2009

/C. Luke Gilligan/
Supervisory Patent Examiner, Art Unit 3626